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Young & Thompson
745 South 23rd street
2nd Floor
Arlington, VA 22202

In re Application of	:	DECISION
Hans Martin GUNDNER et al	:	
Application No.: 10/019,491	:	
PCT No.: PCT/SE00/01407	:	ON PETITION
Int. Filing Date: 03 July 2000	:	
Priority Date: 01 July 1999	:	
Attorney's Docket No.: 56087-66481	:	UNDER 37 CFR 1.47(a)
For: APPARATUS AND METHOD FOR ...	:	
FROM THEFT	:	

This decision is in response to petitioner's "PETITION UNDER 37 CFR 1.47(a)" filed on 22 April 2002 to accept the above-captioned application without the signature of the non-signing joint inventors- Hans Martin GUNDNER, Andreas LOFFLER and Martin VEIT. Petitioner has paid the requisite petition fee of \$130.00 by check.

BACKGROUND

On 03 July 2000, applicant filed international application PCT/SE00/01407, which claimed priority of an earlier Swedish application filed on 01 July 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 January 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 25 January 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 January 2002.

On 31 December 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). No oath or declaration was submitted at such time.

On 22 February 2002, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance 37 CFR 1.497(a) and (b) is required. The notification set two months time limit or 32 months from the priority date for the application, whichever is later to respond.

On 22 April 2002, petitioner submitted, inter alia, a declaration signed by two out of the five inventors accompanied by the present petition.

DISCUSSION

PETITION UNDER 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

“...Where a refusal of the inventor to sign the application paper is alleged, the circumstances of the refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.”

Applicants have satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

With respect to item 1, petitioner has satisfied item 1 because petitioner has provided the fee under 37 CFR 1.17(h).

With respect to item 2, petitioner has not satisfied item 2 because the petition has been reviewed and has not been found to be in compliance with 37 CFR 1.47(a). The petition states that Mr. Johansson's statement is accompanied by separate letters sent registered mail return receipt requested to each of the three non-signing inventors at their respective last known addresses, respectively .

Each of the letters written on January 15, 2002 to the non-signing inventors indicated that a complete copy of the application including the specification of the International publication WO 01/03100, the claims, and a Combined declaration and Power of Attorney as well as the assignment was sent to Hans Martin GUNDNER, Andreas LOFFLER, and Martin VEIT to sign. The letters instructed the inventors to execute the application papers within a time period of 21 days.

Petitioner, however, has not provided copies of the signed registered mail return receipt of each of the three non-signing inventors evidencing that the correspondence was received by them. As of this time, it is only evident that non-signing inventor Gundner received the correspondence and refused to sign the necessary documents as evidenced by his e-mail of 18 February 2002. The others non-signing inventors have not responded. Accordingly, this evidence is insufficient to establish that Andreas LOFFLER, and Martin VEIT refused to sign the declaration.

With respect to item (3), item (3) has been satisfied because petitioner has provided the last known address of each of the non-signing inventors.

With respect to item (4), item (4) has been satisfied because Andreas GUNNARSSON and Mattias FAHLEN have signed the declaration on behalf of non-signing inventors.

Consequently, the petition does not include sufficient factual proof that Andreas LOFFLER, and Martin VEIT refused to sign the required documents.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a).

A proper reply to this decision must include : 1) sufficient proof of refusal or unavailability required under 37 CFR 1.47(a) as indicated above (or an oath/declaration in compliance with 1.497(a)-(b)), and 2) failure to timely submitted the proper reply will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office



Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459



Leonard Smith
PCT Legal Examiner
PCT Legal Office